

## REMARKS

By the present Amendment, claims 1, 11, 14 and 23 have been amended. Claims 1-2, and 4-26 are pending in this application. Applicant respectfully requests reconsideration and withdrawal of the objections and rejections in view of the foregoing amendments and the following remarks.

In response to Examiner's response to Applicant's arguments in the prior response, Applicant has amended the claims to specifically exclude food products from the "promotional item" in claims 1 and 14. Applicant has also amended claims 11 and 23 to define the "collar" as it is defined in the specification for facilitating stacking and unstacking the caps. In regard to Examiner's assertion that the "snap-on" connection is not claimed, Applicant would show that this feature is claimed in claims 12 and 24. In regard to Examiner's assertion that Nava *et al.* teach the removable cap claimed by the present invention in claims 1 and 14, Applicant disagrees. However, Applicant has amended the claims to claim the promotional item as being "inside said cap." Nava *et al.* discloses a CD attached to the outside of the cap and requires the use of two separate components to secure the CD and close the container.

Applicant believes that the amendments to the claims will not require an additional search and requests that Examiner consider these amendments as an attempt to put the Application into a condition that Examiner would consider allowable in light of his arguments in the final Office Action.

## CLAIM REJECTIONS--35 U.S.C. § 102

Examiner rejected claims 1-2, 8-11, 14, and 20-23 under 35 U.S.C. § 102(e) as being anticipated by *Miller* (U.S. Pat. No. 6,474,494). This rejection is respectfully traversed.

In the Office Action, Examiner states as follows:

Miller teaches a portable container comprising a cylindrical receptacle for holding a first product (Figure 1, #18), a removable cap over a first end of the receptacle which acts as a bowl (Figure 1, #14), a removable seal (Figure 1, #12), the cap containing promotional products such as chips and dip (column 4, line 44), the receptacle containing a beverage (column 4, line 18), the receptacle having a hand grip (Figure 1), and a collar (Figure 1, #14BB).

(Office Action dated 01/05/2004 at 2-3.) With all due respect, the prior art cited does not teach the elements of the invention as stated by Examiner. A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). None of the prior art references cited show a container with a food product and a promotional item held separately as is claimed by the present invention.

Claim 1, as amended, reads as follows:

1. A container for holding a plurality of items for use by a consumer, said container comprising:
  - a food product;
  - a promotional item wherein said promotional item is not comprised of food;
  - a receptacle for holding said food product, said receptacle having a first end and a second end; and
  - a removable cap placed over said first end of said receptacle, wherein said removable cap is adapted for holding said promotional item inside said container and separate from said food product while allowing said removable cap to be joined together with said first end of said receptacle, and wherein said container is shaped such that it is portable.

(Claim 1.) With reference to **Figure 11**, Applicants describe an embodiment of the invention with a “promotional item”:

**Figure 11** illustrates a container for holding multiple products in separate compartments in which a pouch is used to hold one of the products inside the cap. . . . Another use of the multi-functional container, for example, is to place food product in the receptacle 1120 of the container while placing a promotional item such as a prize, a toy, a ball, a contest item, a collectible, a coupon, or other non-food item inside a pouch 1130 to be held inside the cap 1110 when the cap 1110 is mated with the receptacle 1120. Although a pouch 1130 is illustrated for holding the promotional item, the pouch is not necessary. The promotional item

can also be placed directly inside the cap 1110 without a pouch or covering. The advantage of placing the promotional item 1130 in the cap rather than in the receptacle 1120 of the container along with the food product is that the food product is kept out of direct or indirect contact with the promotional item 1130 by the membrane or seal 1140 on the receptacle 1120. Thus, any concerns about contamination of the food product by the promotional item 1130 are alleviated. This reduces the cost of compliance with federal regulations regarding items in direct or indirect contact with food products. Prior art containers having promotional items inside the container have placed them either in direct or indirect contact with the food product. The present invention, however, allows the promotional pieces to be placed inside a portable container while keeping the promotional pieces separated from the food product. Furthermore, the present invention allows the volume of the food product in the main body of the container to remain unchanged during a promotional campaign. In prior designs, either the volume of the product must be reduced, or the container size must be increased when a promotional piece is inserted to maintain the same volume of product.

Although the container in **Figure 11** illustrates a single prize being placed inside the cap 1110, the invention is not limited to a single cap or a single prize, nor is the particular shape of the cap limited to that shown. In another embodiment, two caps could be placed on each end with food products and/or promotional items in each cap, or a cap can be placed on one end and a molded prize attached to the other end. For example, in addition to placing a prize or food product inside the cap 1110, another prize that is molded to fit the base of the receptacle 1120 could be removably attached directly to the bottom of the container to form part of the overall shape of the container. This prize could be, for example, an injection molded stencil toy that could be removed by a consumer and a picture drawn by the consumer marking through the stencil onto a piece of paper. In such an embodiment, the portability of the container is maintained while also keeping the food product separate from the promotional items.

(Spec. at 21-22.) As can be understood from the above description, the “promotional item” is defined such that it is not a food product, and is further so limited in the claim itself because of Examiner’s opinion that the term “promotional item” could be a food product. In fact, one of the advantages of the present invention is that the “promotional item” is kept separate from the food product in the receptacle portion of the container. This provides advantages over the prior art in that (1) any concerns about contamination of the food product by the promotional item are alleviated, thus reducing the cost of compliance with federal regulations regarding items in direct or indirect contact with food products, and (2) the present invention allows the volume of the

food product in the main body of the container to remain unchanged during a promotional campaign. In prior designs, either the volume of the product must be reduced, or the container size must be increased when a promotional piece is inserted to maintain the same volume of product.

None of the prior art references cited by Examiner in support of the 102 rejections disclose a container with a promotional item as is claimed by the present invention. Because the references do not disclose a container that holds a promotional item inside the container, but separate from the food product, the present invention is not anticipated.

In regard to *Miller*, Examiner states that the cap contains “promotional products such as chips and dip (column 4, line 44).” Chips and dip are food products and are not promotional items as is claimed by the present invention. Food products are expressly excluded from being a promotional item in claim 1. Notice that the specification, reproduced above, makes a distinction between food products and promotional items. In fact, that was an object of the present invention, to keep the promotional item separate from the food product but still within the overall container. Thus, a food product is not equivalent to a promotional item as those terms are used by Applicants.

Further, *Miller* discloses, “The bowl is utilized for finger foods such as chips or dip etc.” *Miller* teaches using the bowl to consume a food product but does not teach a removable cap that is adapted for holding a promotional item separate from a food product, nor does he teach that the cap can be used as a bowl. In fact, *Miller* teaches that the bowl 14 is not the cap but is simply affixed to the container. A separate cover 12 is used on the beverage container 18. The present invention in claims 1 and 14 claims that the removable cap can both hold the promotional

item inside the cap and join to the receptacle to close the container. Therefore, *Miller* does not anticipate claims 1-2, 8-11, 14, and 20-23.

*Miller* does not disclose a container having a food product. Rather, *Miller* is directed to a “beverage container cover with bowl.” (Abstract.) In claim 1 and claim 14, Applicants claim a food product within the container. Therefore, *Miller* does not anticipate claims 1-2, 8-11, 14, and 20-23.

*Miller* also does not teach a collar as is claimed by the present invention. The item referred to by Examiner is a skirt, not a collar. (Col. 4, lines 46-51.) Further, the skirt is not on the cover 12 but is on the bowl 14. None of the prior art references disclose a collar as claimed by the present invention. The collar of the present invention is described as follows:

Specifically, a collar around the open end of the cap (which is the only portion of the middle cap 510 exposed) provides for easy stacking and unstacking of the caps after manufacture and prior to installation on the receptacle. This collar promotes automatic stacking of the caps without sticking together and increases hoop strength of each individual cap.

(Specification at 15.) Examiner must consider the definition of “collar” in light of the Specification. None of the prior art references show such a collar that would facilitate stacking and unstacking of a plurality of caps as is claimed in claims 11 and 23.

The collar claimed by the present invention facilitates stacking of the removable caps such that they do not stick together. It appears that the bowl and the cover disclosed by *Miller* would stick together if they are stacked. *Miller* does not disclose or even suggest such a feature. Therefore, claims 11 and 23 are not anticipated by *Miller*.

Examiner rejected claims 1-2, 8-10, 13-15, 20-22, and 25 under 35 U.S.C. § 102(e) as being anticipated by *Lee et al.* (U.S. Pat. No. 6,068,865). This rejection is respectfully traversed. In the Office Action, Examiner states as follows:

Lee et al. teach a portable container comprising a cylindrical receptacle for holding a first product (Figure 1, #30), a removable cap over a first end of the receptacle which was capable of acting as a bowl when inverted (Figure 1, #20), a removable seal (Figure 1, #32), the cap containing promotional products such as chocolate (Figure 2, #24), the receptacle containing yoghurt (Figure 2, #34), the receptacle having a shape that provided a hand grip (Figure 1, #30), the cap having a collar or rim (Figure 1, #20), and the cap being transparent (column 6, line 30).

(Office Action dated 01/05/2004 at 3.) With all due respect, *Lee et al.* do not teach the elements of the invention as stated by Examiner. Examiner must show that every single identical element claimed is disclosed in the prior art reference arranged as they are in the claims. Here, there are a number of distinctions between the rejected claims and *Lee et al.*

First, *Lee et al.* do not disclose a container having a promotional item. As discussed above in regard to the *Miller* reference, a food product is not equivalent to a promotional item as those terms are used by Applicants and as specifically stated in claims 1 and 14. Examiner states that *Lee et al.* teach a “cap containing promotional products such as chocolate.” Chocolate is a food product that is meant to be consumed. It is not a promotional item as is claimed by the present invention in claims 1 and 14 for the same reasons argued above in regard to the *Miller* reference. Thus, *Lee et al.* do not anticipate claims 1-2, 8-10, 13-15, 20-22, and 25.

Second, *Lee et al.* do not teach a collar as is claimed by the present invention for the same reasons argued above in regard to the *Miller* reference. It appears that the bowl and the cover disclosed by *Lee et al.* would stick together if they are stacked. *Lee et al.* does not disclose or even suggest a collar for facilitating stacking and unstacking as is claimed in claims 11 and 23. Therefore, *Lee et al.* do not anticipate claims 11 and 23.

Examiner rejected claims 1-2, 8-12, 14-15, and 20-24 under 35 U.S.C. § 102(b) as being anticipated by *Le Rose* (U.S. Pat. No. 2,076,132). This rejection is respectfully traversed. In the Office Action, Examiner states as follows:

Le Rose teaches a portable container comprising a cylindrical receptacle for holding a first product (Figure 1, #7), a removable cap over a first end of the receptacle which was capable of acting as a bowl when inverted (Figure 1, #15), a removable seal (Figure 2, #13), the cap containing promotional products such as ice cream (column 2, line 16), the receptacle containing soda (column 1, line 7), the receptacle having a shape that provided a hand grip (Figure 1, #9), the cap having a collar (Figure 1, #19), and the cap having a lip which engaged a groove in the receptacle (column 2, line 25).

(Office Action dated 01/05/2004 at 3.) With all due respect, *Le Rose* does not teach the elements of the invention as stated by Examiner. Examiner must show that every single identical element claimed is disclosed in the prior art reference arranged as they are in the claims. Here, there are a number of distinctions between the rejected claims and *Le Rose*.

First, *Le Rose* does not disclose a container having a promotional item. As discussed above in regard to the *Miller* reference, a food product is not equivalent to a promotional item as those terms are used by Applicants and as specifically stated in claims 1 and 14. Examiner states that *Le Rose* teaches a “cap containing promotional products such as ice cream.” Ice cream is a food product that is meant to be consumed. It is not a promotional item as is claimed by the present invention in claims 1 and 14 for the same reasons argued above in regard to the *Miller* reference. Further, *Le Rose* does not teach keeping the promotional item separate from a food product. Thus, *Le Rose* does not anticipate claims 1-2, 8-12, 14-15, and 20-24.

Second, *Le Rose* does not teach a collar as is claimed by the present invention for the same reasons argued above in regard to the *Miller* reference. The cap disclosed by *Le Rose* does not facilitate stacking and unstacking like the cap claimed in claims 11 and 23. Therefore, *Le Rose* does not anticipate claims 11 and 23.

Third, *Le Rose* does not teach a cap with “a lip protruding inward from an outside edge of said cap for engaging a groove on said first end of said receptacle such that said cap and said receptacle are held together securely” as is claimed by the present invention in claims 12 and 24. Rather, *Le Rose* teaches that the rim 19 is screw threaded. A thread is not identical to the lip claimed by the present invention. A threaded connection requires more effort and time to remove and replace than does the snap-on connection claimed by the present invention. Therefore, *Le Rose* does not anticipate claims 12 and 24.

Examiner rejected claims 1, 3-4, and 8-11 under 35 U.S.C. § 102(e) as being anticipated by *Nava et al.* (U.S. Pat. No. 6,070,752). This rejection is respectfully traversed. In the Office Action, Examiner states as follows:

*Nava et al.* teach a portable container comprising a generally cylindrical receptacle for holding a first product (Figure 1, #8), a removable cap over a first end of the receptacle which was capable of acting as a bowl when inverted (Figure 1, #10), the cap containing promotional products such as CD's (Figure 2, # 16), the receptacle containing soda (Figure 1, #9), the receptacle having a shape that provided a hand grip (Figure 1, #8), and the cap having a collar or rim (Figure 1, #23).

(Office Action dated 01/05/2004 at 4.) With all due respect, *Nava et al.* do not teach the elements of the invention as stated by Examiner. Examiner must show that every single identical element claimed is disclosed in the prior art reference arranged as they are in the claims. Here, there are a number of distinctions between the rejected claims and *Nava et al.*

First, *Nava et al.* does not disclose a container having a food product. Rather, *Nava et al.* is directed to a “closure for use with a drink container.” (Abstract) The Applicants in claim 1 and claim 14 claim a food product within the container. Therefore, claims 1, 3-4, and 8-11 are not anticipated by *Nava et al.*

Second, *Nava et al.* does not teach “a removable cap placed over said first end of said receptacle, wherein said removable cap is adapted for holding said promotional item inside said container and separate from said food product while allowing said removable cap to be joined together with said first end of said receptacle” as is claimed in claim 1 and similarly in claim 14.

The cap disclosed by *Nava et al.* does not meet this claim limitation because the CD 16 is held on the outside of the inner member 12 with an outer member 14. Thus, there are two separate pieces, one for sealing the container 8, and the other for holding the CD 16 to the outside of the inner member 12. The present invention, on the other hand, claims a removable cap that holds the promotional item inside the removable cap without the necessity of a separate special cap for the promotional item. Thus, the container of claims 1 and 14 of present invention provides greater utility and ease of construction. The container disclosed by *Nava et al.* would be more expensive to manufacture in that two separate pieces must be made for the closure. Further, the container of *Nava et al.* is not as versatile as the container claimed in the present invention because of the limited space for placing a promotional item. In fact, it appears that the container in *Nava et al.* could only be used for the specific purpose of holding a CD. The container of the present invention can hold promotional items of a variety of shapes and sizes. Therefore, claims 1, 3-4, and 8-11 are not anticipated by *Nava et al.*

Third, *Nava et al.* do not disclose a removable cap that is “seatable on said first end of said receptacle such that said cap is usable as a bowl for holding said food product during consumption” as is claimed by claim 8. *Nava et al.* do not even disclose a bowl. Therefore, claim 8 is not anticipated by *Nava et al.*

Fourth, *Nava et al.* do not teach a collar as is claimed by the present invention for the same reasons argued above in regard to the *Miller* reference. The cap disclosed by *Nava et al.*

does not facilitate stacking and unstacking like the cap claimed in claims 11 and 23. Therefore, claims 11 and 23 are not anticipated by *Nava et al.*

Therefore, Applicants request that Examiner reconsider the 35 U.S.C. § 102 rejections in light of the foregoing amendments and remarks. Applicants request that Examiner either withdraw these rejections or provide a proper basis for the rejection of claims 1-2, 4, 8-15 and 20-25. If Examiner is still of the opinion that the present invention is anticipated by prior art, Applicants request that Examiner specifically point out each element of the claimed invention and where that element is found in the prior art reference.

#### **CLAIM REJECTIONS--35 U.S.C. § 103**

Throughout the obviousness rejections, it appears that Examiner is focusing only on the particular element claimed in the dependent claim at issue. Applicants would respectfully remind Examiner that all limitations of the claimed invention must be considered when determining patentability. *See In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). The fact that a claimed element may exist in the prior art does not mean that the claimed combination is obvious in view of the prior art. Examiner must show some suggestion or motivation somewhere in the prior art to make the combination. Applicants request that Examiner indicate the suggestion or motivation that exists in the prior art that would motivate one with skill in the art to make the combination at issue. When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

MPEP § 2141; *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187

n.5 (Fed. Cir. 1986).

In determining whether particular references might be properly combined, whether it is obvious to try a combination is not a legitimate test. *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988). The test is whether the combination of the references or modification would be obvious to **do** rather than obvious to **try**. *In re Deuel*, 51 F.3d 1552, 1559, 34 U.S.P.Q.2d 1210, 1216 (Fed. Cir. 1995). A general incentive does not make obvious a particular result, nor does the mere existence of techniques which may be carried out to achieve the particular result. *Id.* A proper *prima facie* case of obviousness requires that the prior art reveal a reasonable expectation of success carrying out the proposed combination or modification. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). Both the suggestion and the reasonable expectation of success must be found in the prior art, not in the applicant's disclosure. *Id.*

Examiner rejected claims 5-7 under 35 U.S.C. § 103(a) as being unpatentable over *Nava, et al.* in view of *Kirshenbaum, et al.*, (US Patent No. 4,051,265). This rejection is respectfully traversed. In the Office Action, Examiner states as follows:

*Nava et al teaches the above mentioned components. Nava et al do not teach an outer layer which carries graphics and provides an oxygen barrier. Kirshenbaum et al teach a container and cap with an outer layer which provided an oxygen barrier (Figure 1, #14; abstract), as well as the use of graphics (column 5, lines 50-62). It would have been obvious to one of ordinary skill in the art to incorporate the outer layer of Kirshenbaum et al into the invention of Nava et al since both are directed to beverage containers, since Nava et al already included a sealed container (Figure 1, #8 & 10), and since the outer layer of Kirshenbaum et al provided an effective oxygen barrier and thus better preserved the beverage (abstract). It would have been obvious to one of ordinary skill in the art to include graphics on the outer layer of Kirshenbaum et al since Kirshenbaum et al already included graphics on the container itself (column 5, lines 50-62), since outer layers commonly included graphics, and since graphics on the outer layer*

would have made the product more distinctive looking and set it apart from its competitors.

(Office Action dated 01/05/2004 at 4-5.) *Nava et al.* do not teach the claimed limitations of claim 1 as asserted by Examiner for the same reasons argued above in regard to the 35 U.S.C. § 102 rejections. Among other things, *Nava et al.* does not teach a container having a food product, they do not teach “a removable cap placed over said first end of said receptacle, wherein said removable cap is adapted for holding said promotional item inside said container and separate from said food product while allowing said removable cap to be joined together with said first end of said receptacle” as is claimed in claim 1. Furthermore, neither *Kirshenbaum et al.* nor *Nava et al.* provide any motivation or suggestion to combine the outer layer claimed in claims 5-7 with the container disclosed in *Nava et al.* Because the combinations claimed in claims 5-7 are not suggested in the prior art, these claims are patentable over the prior art.

Examiner rejected claim 16 under 35 U.S.C. § 103(a) as being unpatentable over *Le Rose* in view of *Nava et al.* (U.S. Pat. No. 6,070,752). This rejection is respectfully traversed. In the Office Action, Examiner states as follows:

Le Rose teaches the above mentioned components. Le Rose does not teach the promotional item being a prize, toy, coupon, ball, contest item, or collectible. *Nava et al* teach a portable container comprising a generally cylindrical receptacle for holding a first product (Figure 1, #8), a removable cap over a first end of the receptacle which was capable of acting as a bowl when inverted (Figure 1, #10), and the cap containing a contest item such as CD's (Figure 2, #16). It would have been obvious to one of ordinary skill in the art to incorporate the contest item of *Nava et al* into the invention of Le Rose since both are directed to beverage containers, since Le Rose already included a cap which contained a promotional item (Figure 1, #15), and since the contest item of *Nava et al* would have improved the consumer's desire to purchase the product due to their chance of winning a prize.

(Office Action dated 01/05/2004 at 5.) *Le Rose* does not teach the claimed limitations of claim 14 as asserted by Examiner for the same reasons argued above in regard to the 35 U.S.C. § 102

rejections. Among other things, *Le Rose* does not teach a container that holds a food product and a promotional item separate from each other. On this basis alone, claim 16 is not obvious.

Applicants respectfully request that the Examiner comply with 37 C.F.R. § 1.106(b) and provide a proper rejection subject to traversal by Applicants, designating the particular parts relied upon and clearly explaining the pertinence of each reference.

Nevertheless, *Nava et al.* provide no motivation or suggestion to combine the promotional item claimed in claim 16 with the container in *Le Rose* to reach the present invention. Examiner has used the benefit of hindsight to argue that the combination is obvious on the basis that each of the prior art references have all the elements of the claimed invention. While Applicants do not agree that all elements are present in the prior art, even if all the elements existed in the prior art, there is no suggestion in the prior art to make the combination suggested by Examiner. Indeed, Examiner cannot point to a statement in either *Le Rose* or *Nava et al.* that suggests the combination. Just because the combination is better and would improve “the consumer’s desire to purchase the product,” this does not provide a basis for an obviousness rejection. This only means that the combination is useful, not that it is obvious. Further, as argued above, *Le Rose* does not disclose a promotional item. Certainly the fact that *Nava et al.* and *Le Rose* both disclose beverage containers also does not provide any support for an obviousness rejection because this is not a suggestion to make the claimed combination. Therefore, Applicants request that Examiner either point out the suggestion in the prior art to make the combination claimed or allow claim 16.

Examiner rejected claims 17-19 under 35 U.S.C. § 103(a) as being unpatentable over *Le Rose* in view of *Nava et al.* and further in view of *Kirshenbaum et al.* This rejection is respectfully traversed. In the Office Action Examiner states as follows:

Le Rose and Nave et al teach the above mentioned components. Le Rose and Nava et al do not teach an outer layer which carries graphics and provides an oxygen barrier. Kirshenbaum et al teach a container and cap with an outer layer which provided an oxygen barrier (Figure 1, #14; abstract), as well as the use of graphics (column 5, lines 50-62). It would have been obvious to one of ordinary skill in the art to incorporate the outer layer of Kirshenbaum et al into the invention of Le Rose, in view of Nava et al, since both are directed to beverage containers, since Nava et al already included a sealed container (Figure 1, #8 & 10), and since the outer layer of Kirshenbaum et al provided an effective oxygen barrier and thus better preserved the beverage (abstract). It would have been obvious to one of ordinary skill in the art to include graphics on the outer layer of Kirshenbaum et al since Kirshenbaum et al already included graphics on the container itself (column 5, lines 50-62), since outer layers commonly included graphics, and since graphics on the outer layer would have made the product more distinctive looking and set it apart from its competitors.

(Office Action dated 01/05/2004 at 6.) *Le Rose* and *Nava et al.* do not teach the claimed limitations of claim 14 as asserted by the Examiner for the same reasons argued above in regard to the 35 U.S.C. § 102 rejections. On this basis alone, claims 17-19 are not obvious in view of the prior art. Among other things, *Le Rose* does not teach “a removable cap placed over said first end of said receptacle, wherein said removable cap is adapted for holding said promotional item inside said container and separate from said food product while allowing said removable cap to be joined together with said first end of said receptacle” as is claimed in claim 1. Furthermore, neither *Kirshenbaum et al.* nor *Le Rose* provides any motivation or suggestion to combine the outer layer claimed in claims 5-7 with the container disclosed in *Le Rose*. Because the combinations claimed in claims 5-7 are not suggested in the prior art, these claims are patentable over the prior art.

Examiner rejected claim 26 under 35 U.S.C. § 103(a) as being unpatentable over *Le Rose* in view of *Howes* (U.S. Pat. No. 5,076,433). This rejection is respectfully traversed. In the Office Action, Examiner states as follows:

Le Rose teaches the above mentioned components. Le Rose does not teach a promotional item attached to a second end of the receptacle. Howes teaches a

container comprising a promotional item attached to a second end of the receptacle (Figure 1, #21). It would have been obvious to one of ordinary skill in the art to incorporate the bottom attached promotional item of Howes into the invention of *Le Rose* since both are directed to beverage containers, since *Le Rose* already included an additional product attached to the first end (Figure 2, #16), since consumers greatly valued promotional items such as prizes, and since the bottom promotional item of Howes has the advantage of providing a prize, while being completely indistinguishable from a non-prize bearing container (column 2, lines 39-48).

(Office Action dated 01/05/2004 at 6-7.) *Le Rose* does not teach the claimed limitations of claim 14 as asserted by Examiner for the same reasons argued above in regard to the 35 U.S.C. § 102 rejections. Among other things, *Le Rose* does not teach a container that holds a food product and a promotional item separate from each other as claimed in claim 14. On this basis alone, claim 16, which depends from claim 14, is not obvious. Applicants respectfully request that Examiner comply with 37 C.F.R. § 1.106(b) and provide a proper rejection subject to traversal by Applicants, designating the particular parts relied upon and clearly explaining the pertinence of each reference.

Nevertheless, *Howes* provides no motivation or suggestion to combine the promotional item claimed in claim 26 with the container in *Le Rose* to reach the present invention. Examiner has used the benefit of hindsight to argue that the combination is obvious on the basis that each of the prior art references have all the elements of the claimed invention. While Applicants do not agree that all elements are present in the prior art, even if all the elements existed in the prior art, there is no suggestion in the prior art to make the combination suggested by Examiner. Indeed, Examiner cannot point to a statement in either *Le Rose* or *Howes* that suggests the combination. Just because the combination is better and “consumers greatly value[] promotional items such as prizes,” this does not provide a basis for an obviousness rejection. This only means that the combination is useful, not that it is obvious. Further, as argued above, *Le Rose*

does not disclose a promotional item attached to the first end. Certainly the fact that *Howes* and *Le Rose* both disclose beverage containers also does not provide any support for an obviousness rejection because this is not a suggestion to make the claimed combination. Further, the “advantage of providing a prize, while being completely indistinguishable from a non-prize bearing container,” is not a suggestion to make the claimed combination. Therefore, Applicants request that Examiner either point out the suggestion in the prior art to make the claimed combination or allow claim 26.

### **CONCLUSION**

Applicant has reviewed the prior art cited by Examiner in the Notice of References Cited of the Office Action and asserts that none of the prior art references, either alone or in combination, are relevant to the patentability of the Applicant’s invention.

If there are any outstanding issues, which the Examiner feels may be resolved by way of a telephone conference, the Examiner is cordially invited to contact Vincent J. Allen at 972-367-2001.

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